

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte FRITZ ECKSTEIN, WOLFGANG PIEKEN,
FRITZ BENSELER, DAVID B. OLSEN,
DAVID M. WILLIAMS, and OLAF HEIDENREICH

Appeal No. 2002-1165
Application No. 08/936,657

ON BRIEF

Before WILLIAM F. SMITH, GRIMES, and GREEN, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly we remand the application to the examiner to consider the following issues and to take appropriate action.

Claims 44 through 57 stand rejected under 35 U.S.C. § 112, first paragraph (enablement). Claim 44 on appeal, the only independent claim, reads as follows:

44. A method of cleaving a target RNA molecule comprising the step of providing said target RNA molecule with a catalytic RNA molecule under conditions suitable for said catalytic RNA molecule to cleave said target RNA molecule, wherein said catalytic RNA molecule comprises at least one modified nucleoside, said modified

MAILED

SEP 30 2003

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

nucleoside comprising a modifier group, selected from the group consisting of halo, sulfhydryl, azido, amino, monosubstituted amino and disubstituted amino groups replacing a hydroxy group at the ribose sugar 2'-position.

In response to the examiner's rejection, appellants reply upon a declaration filed under 37 CFR § 1.132 by Dr. Dan T. Stinchcomb executed April 30, 1996. In reviewing Dr. Stinchcomb's declaration, we note that he refers to application 08/434,547 in paragraph 2, now issued as U.S. Patent No. 5,817,635 ('635 patent). The '635 patent is stated to be a division of application 07/965,411 which is the parent application of this application. Thus, the '635 patent and this application should share a common disclosure. Claim 1 of the '635 patent reads as follows:

1. A method of using an RNA molecule having catalytic activity as a therapeutic agent or biocatalyst, wherein said RNA molecule comprises at least one modified nucleoside, wherein the hydroxy group at the 2'-position of the ribose sugar is replaced by a modifier group, selected from halo, azido, amino, monosubstituted amino and disubstituted amino groups.

Claim 1 of the '635 patent as well as all of the other claims in the patent are presumed valid. 35 U.S.C. § 282. Thus, claim 1 of the '635 patent is presumed to be enabled. In comparing the subject matter of claim 1 of the '635 patent and claim 44 on appeal, it appears that claim 44 on appeal subsumes or at least significantly overlaps the subject matter of claim 1 of the '635 patent. Thus, a conflict exists in that, if claim 44 on appeal is not enabled, it is not seen how claim 1 of the '635 patent is enabled.

On return of the application, the examiner should take a step back and review the present enablement issue. In so doing, the examiner should take into account the claims of the '635 patent and the prosecution history thereof. While the examiner may

maintain a rejection of the claims on appeal if appropriate, maintenance of such a rejection appears to require the signature of the TC Director. See MPEP § 2307.02.

As a second matter, we note appellants filed a Reply Brief (Paper No. 30, February 22, 2001). The examiner noted the Reply Brief and forwarded the file to the Board. Paper No. 31, March 12, 2001. In reviewing the matter, we believe a substantive response from the examiner to each of the points raised in the Reply Brief would be helpful in deciding the issues raised in this appeal. Accordingly, if the examiner decides to maintain an enablement rejection in this case having obtained the approval of the TC Director, we ask the examiner enter a substantive response to each argument presented in the Reply Brief. If otherwise appropriate, we authorize a Supplemental Examiner's Answer under 37 CFR § 1.193(b)(1) for this purpose.

REMANDED

William F. Smith
William F. Smith)
Administrative Patent Judge)
)
Eric Grimes) BOARD OF PATENT
Eric Grimes)
Administrative Patent Judge) APPEALS AND
)
Lora M. Green) INTERFERENCES
Lora M. Green)
Administrative Patent Judge)

Appeal No. 2002-1165
Application No. 08/936,657

Page 4

McDonnell, Boehnen, Hulbert & Berghoff
300 South Wacker Drive, Suite 3200
Chicago, IL 60606

dem